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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,447	04/02/2001	Tetsuya Ikemoto	210485	9485

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[REDACTED] EXAMINER

COVINGTON, RAYMOND K

ART UNIT	PAPER NUMBER
1625	[REDACTED]

DATE MAILED: 01/29/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/824,547

Applicant(s)

Berlin et al

Examiner

Raymond Covington

Art Unit

1625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on 6/29/2001, 9/10/2001, 10/15/2001
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-19 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

- a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15)  Notice of References Cited (PTO-892)
- 16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3,4,5
- 18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19)  Notice of Informal Patent Application (PTO-152)
- 20)  Other: \_\_\_\_\_

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bogeso et al US 4,136,193 taken with Petersen et al UK 2,357,762.

Bogeso et al US '193 teach 1-dimethylaminopropyl-1-phenyl phthalans (citalpram) derivatives of the type recited in the claims. See, for example, column 2 lines 12-29. Partentees do not expressly show the recited particle sizes set forth in applicants' claims. However, Petersen et sl UK '762 teach analogous citalpram derivatives with particle sizes within the claimed range. See, for example, page 13 lines 5-14 and page 2 fourth paragraph. To modify the teaches of Bogeso et al US '193 in light of Petersen et al UK '193 would have been obvious to one of ordinary skill in the art as the results, ease of handling and product formulation, would not have been unexpected and therefore unpatentable.

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3. Claims 9-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petersen et al UK 2,357,762 taken with Ram Chem. Abs. Vol. 113 No. 231122.

Petersen et al UK '193 teach a process for making crystalline citalopram in the same type manner as recited in the claims. See, for example, paragraph abridging pages 3 and 4, page 5 lines 15-19 and lines 20-31 and page 12 lines 1-14. Patentees do not specifically disclose the use of acetone. However, Ram teaches is known for use in citalopram processes. To employ acetone in the process of Petersen et al US '193 would have been obvious to one of ordinary skill in the art, particularly in further light of use by Petersen et al of acetate under process conditions which would produce the acetone in situ. See page 5 line 15-19. Thus to modify Petersen et al to obtain enhanced and simplified process conditions would have been obvious to one of ordinary skill in the art and therefore unpatentable.

No claim is allowed.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Covington whose telephone number is (703)308-4704.

*P*  
Covington:mv

January 10, 2002

*Alan L. Rotman*  
ALAN L. ROTMAN  
PRIMARY EXAMINER  
SPE A.U. 1625